

R¹ represents 2,2-difluoro-ethyl,

R² represents (6-)ethyl, and

R³ represents 4,5-dimethyl-2,4-dihydro-3H-1,2,4-triazol-3-on-2-yl.

Claim 5 (original)

5. An herbicidal composition composing an herbicidally effective amount of a compound according to claim 1 and an inert carrier.

Claim 6 (original)

6. A method of controlling unwanted vegetation which comprises applying to such vegetation or to a locus from which it is desired to exclude such vegetation an herbicidally effective amount of a compound according to claim 1.

REMARKS

Grounds for Filing Reissue Application

MPEP 1402 states:

"In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent..."

The most common bases for filing a reissue application are:

- (A) the claims are too narrow or too broad
- (B) the disclosure contains inaccuracies;
- (C) applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior co-pending applications."

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening:

This reissue application is a broadening reissue which seeks to introduce the phrase "or a salt of the compound of formula (I)," (hereafter referred to as the "amended salt phrase") into claim 1 of U.S.

Patent 6,251,831, which was inadvertently deleted from the claim language during prosecution.

The preliminary amendment of 30 December 1998 cancelled claims 1-3 and 5-10 and introduced new claim 11 which became the new independent claim; claims 1 and 11 both contained the phrase “and salts of compounds of the formula (I)” (hereafter referred to as the “original salt phrase” - The amended salt phrase has been added to promote singular-singular term agreement). The original salt phrase was maintained through the applicants’ response to restriction requirement (5 May 1999) and response to the first office action (5 August 1999).

A continuing prosecution application was filed on 24 February 2000 which included a preliminary amendment which cancelled claim 11 in favor of new independent claim 17. This claim 17 inadvertently omitted the original salt phrase which had been present in claim 11. As no objection or rejection had been made by the examiner that the scope of the claimed compounds also included salt forms of the claimed compounds, this omission was made in error.

The original and amended salt phrases are supported throughout the specification (see e.g. col. 1, line 57 of U.S. Patent 6,251,831) and the original salt phrase was part of the originally filed claim 1 (see page 264, line 18) and as such does not constitute new matter. Moreover, the omission of the original/amended salt phrase resulted in the patentee claiming “less than he had a right to claim” and because the specification and originally filed claims support the “salt” phrase, the claims of ‘831 are partly inoperative in failing to protect against infringement all embodiments of the patentee’s invention and as such reissue is available to broaden the scope of the claims, see *Chisum on Patents*, page 15-33, Chapter 15.03[1] - see also *Ex parte Heathcock*, 134 USPQ 446 (POBA 1962) and *In re Salem*, 553 F.2d 676, 193 USPQ 513 (CCPA 1977).

Diligence in Filing Reissue Application

MPEP 1403 states:

“When a reissue application is filed within 2 years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made. *Ex parte Lafferty*, 190 USPQ 202 (Bd. App. 1975); but see *Rohm & Haas Co. v. Roberts Chemical Inc.*, 142 F. Supp. 499, 110 USPQ 93 (S.W. Va. 1956), *rev’d on other grounds*, 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).”

U.S. Patent 6,251,831 was issued on 26 June 2001 which is within two-years of the date of this filing.

Proof of Ownership of Assignee

Pursuant to MPEP 1410.01:

"The assignee must establish its ownership in accordance with 37 CFR 3.73(b) by:

- (A) filing in the reissue application documentary evidence of a chain of title from the original owner to the assignee; or
- (B) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.)."

Evidence of ownership by the assignee (Bayer Aktiengesellschaft) can be found in the Notice of Recordation of Assignment, Reel 9213, Frame Number 0736, which was recorded on 14 May 1998 (which was filed in the parent application SN: 09/006,686). A copy of this Notice is attached to this communication.

Claim for Foreign Priority Under 35 U.S.C. 119(a)-(d)

Pursuant to MPEP 1417, the applicants resubmit on the attached Application Data Sheet (in lieu of on the oath and declaration) their claim for foreign priority over:

Country	Application No.	Filing Date
DE	195 25 162	11 July 1995
EP	96 02826	28 June 1996

(Note: According to MPEP 1417, no additional certified copy is necessary)

Comments About Amendments Made

Claim 1 has been amended to include the phrase "or salt of the compound of formula (I)". It is believed that no new matter has been added. Claims 1-6 are pending.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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Attachments: copy of Notice of Recordation of Assignment